APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,651	12/30/2003	Roy Ben-Yoseph	06975-498001 / Security 3	1575

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EXAMINER
JEAN, FRANTZ B

ART UNIT	PAPER NUMBER
2454	

NOTIFICATION DATE	DELIVERY MODE
02/20/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

	Application No.	Applicant(s)
Office Action Summary	10/747,651	BEN-YOSEPH ET AL.
	Examiner	**Art Unit**	
	Frantz B. Jean	2454	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 June 2008</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-193</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-193</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>See Continuation Sheet</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____

5)☐ Notice of Informal Patent Application

6)☐ Other: _____

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date
:2/19/04,3/17/04,3/28/05,2/23/07,12/21/07,7/17/08,10/06/08.

DETAILED ACTION

This office action is in response to applicant's response filed on 6/05/08. Claims 1-193

are pending in the application.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 2/19/04, 3/17/04,

3/28/05, 2/23/07, 12/21/07, 7/17/08 and 10/06/08 is in compliance with the provisions of

37 CFR 1.97. Accordingly, the information disclosure statement is being considered by

the examiner.

The double patenting rejection has been maintained. Examiner believes that the claims

of the applications discussed below are too close in term of content and concept.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees.   A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct
from the reference claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.
1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422
F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).
    A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)
may be used to overcome an actual or provisional rejection based on a nonstatutory
double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-193 of the instant application are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-63 of copending Application No.10/747,263, claims 1-55 of copending application 10/747,676 and claims 1-4, 6-23, and 25-39 of copending application 10/747,678. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are arguably broader than the claims of applications "263", "676" and "678", which encompass the same metes, bounds, and limitations. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to eliminate the limitations of the narrower claims, since it has been held that omission of an element and its function and a combination where the remaining elements perform the same functions as before involves only routine skill in the art. See in re Karlson, 136 USPQ 184

This is a _provisional_ obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the claimed invention is directed to non-statutory subject matter. Claims 97-192 are

directed to a non-statutory invention. Page 28 of the specification states that the

techniques described in the invention as claimed are not limited to any particular

hardware or software configuration. Rather, it may be implemented using hardware or

software, or a combination of both. Applicant is requested to include storage before

medium or any other term/language acceptable by the USPTO to correct the deficiency.

Unfortunately, the term tangible in front of tangible is no longer acceptable.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the
applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States
only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

Claims 1-193 are rejected under 35 U.S.C. 102(e) as being anticipated by

Dieterman US patent Number 6,393,464.

As per claim 1, Dieterman teaches a method comprising: maintaining a list of

people associated with a user (*see abstract; col. 2 lines 1-3 wherein the method*

comprises steps of creating an allowed list of electronic addresses with which the user

is permitted to freely exchange messages); inferring that a person is associated with the

user based, at least in part, on inclusion of the person in a contact list of a second

person, wherein the second person is not the user (*messages sent are categorized; see col. 2 lines 3-6; abstract*); adding the inferred person to the list (*contact can be added, edited, and deleted on the list; col. 3 lines 53-57*); adding the inferred person to the list of people associated with the user (*contact can be added, edited, and deleted on the list; col. 3 lines 53-57*); and using the list to control aspects of communications between the user and others based on whether the others are included on the list (*identifications comprise any identifying means which another entity can communicate with; see col. 3 lines 59-62*).

As per claim 2, Dieterman teaches a method of claim 1 wherein the person is included in a contact list of the user (col. 1 lines 12-15).

As per claim 3, Dieterman teaches contact list of the user that is a buddy list (see abstract; fig 7).

As per claim 4, Dieterman teaches e-mail communications, the method further comprising inferring that a person is associated with the user based, at least in part, on positive user actions related to e-mail communications from the person (col 1 lines 12-15).

As per claim 5, Dieterman teaches positive actions include sending an e-mail to the person (fig 2; col 1 lines 12-15; col. 2 lines 20-25).

As per claim 6, Dieterman teaches positive actions include replying to, forwarding, saving, or printing an e-mail received from the person (col. 4 lines 22-35).

As per claim 7, Dieterman teaches a method of claim 4 wherein the positive actions include moving an e-mail from a first folder to a second folder (fig 5-10; inbox and outbox).

As per claim 8, Dieterman teaches the first folder is an inbox folder and the second folder is a folder other than a delete folder or a spam folder (fig 5-10).

As per claim 9, Dieterman teaches the positive action includes maintaining an e-mail from the person in an open state for a predetermined period of time (*see fig 5, steps 60 and 61; the message will be erased if disapproved*).

As per claim 10, Dieterman teaches inferring that a person is associated with the user based, at least in part, on detecting a communication between the user and the person (col 2 lines 20-25).

As per claim 11, Dieterman teaches communication that can be is an instant messaging communication or email and other (abstract; fig 3-6).

As per claim 12, Dieterman teaches detecting user actions that mitigate against factors that otherwise are used to infer a person is associated with the user (col. 2 lines 20-25).

As per claim 13, Dieterman teaches the user taking steps to report a communication from the person as spam (fig 6, element 88).

As per claim 14, Dieterman teaches the user taking steps to add a person to a blacklist (fig 2, elements 15-17).

As per claim 15, Dieterman teaches the user taking steps to move a communication from the person to at least one of a spam folder or a delete folder (fig 4, element 77).

As per claim 16, Dieterman teaches users that are people not distrusted by the user (col 2 lines 3-6; categorizing message).

As per claim 17, Dieterman teaches using the list as a white list such that communications received from people on the list are exempt from spam filtering. (col. 2 lines 7-10)

As per claim 18, Dieterman teaches using the list to restrict received communications to those communications from people on the list (categorizing message; (col. 2 lines 3-6).

As per claim 19, Dieterman teaches communications are e-mails (fig 2 element 17).

As per claim 20, Dieterman teaches communications that can be are instant messages, email and other (see abstract; fig 2-6).

As per claim 21, Dieterman teaches people associated with the user are people known to the user (categorizing message; col. 2 lines 3-6).

As per claim 22, Dieterman teaches using the list to filter a display of e-mail such that e-mails from people on the list are shown on the display and e-mails from people not on the list are absent from the display (fig 2 discloses screen display; see col. 2 lines 51-53).

As per claim 23, Dieterman teaches using the list to filter a display of e-mail such that e-mails from people not on the list are shown on the display and e-mails from people on the list are absent from the display (col. 2 lines 51-53).

As per claim 24, Dieterman teaches using the list to restrict which instant messaging interfaces display an online presence of the user to those instant messaging interfaces associated with people on the list (col. 2 lines 51-53).

As per claim 25, Dieterman teaches method using the list as a white list operating in

conjunction with parental controls to filter communications from people not on the list
when the communications include indicia that the content of the communication is
inappropriate for a teen or child account user (col. 6 lines 46-50).

As per claim 26, Dieterman teaches blocking the communications from people not on
the list when the communications include indicia that the content of the communication
is inappropriate for a teen or child account user (col. 2 lines 8-13).

As per claim 27, Dieterman teaches placing communications from people not on the list
in a spam folder the communications include indicia that the content of the
communication is inappropriate for a teen or child account user (col. 2 lines 8-13).

As per claim 28, Dieterman teaches the spam folder is locked from the teen or child
account user (col. 2 lines 13-18).

As per claim 29, Dieterman teaches communications that are e-mails (fig 2, element
17).

As per claim 30, Dieterman teaches method of claim 1 wherein inferring that a person
is associated with the user based, at least in part, on inclusion of the person in a contact
list of a person other than the user comprises inferring that a person is associated with
the user based, at least in part, on inclusion of the person in a contact list of a person

who is listed in a contact list of the user (col. 1 lines 12-15).

As per claim 31, Dieterman teaches inferring that a person is associated with the user based, at least in part, on inclusion of the person in a contact list of a person other than the user comprises inferring that a person is associated with the user based, at least in part, on inclusion of the person in a contact list of a person who is listed in a buddy list of the user (col. 1 lines 12-15; col. 2 lines 11-13; fig 7-8).

As per claim 32, Dieterman teaches method of claim 1 wherein inferring that a person is associated with the user based, at least in part, on inclusion of the person in a contact list of a person other than the user comprises inferring that a person is associated with the user based, at least in part, on the inclusion of the person in a contact list of a person who the user has added to a buddy list of the user (col. 1 lines 12-15; col. 2 lines 11-13; fig 7-8).

Claims 33-192 are method and computer usable medium that contain the same limitations as discussed in claims 1-32 above. They are rejected under the same rationale.

As per claim 193, Dieterman teaches a method, comprising:

maintaining a first list of online identities associated with an online identity of a first user (*see abstract; col. 2 lines 1-3 wherein the method comprises steps of creating an allowed list of electronic addresses with which the user is permitted to freely exchange messages)*; accessing a second list of online identities associated with an online

identity of a second user other than the first user (*messages sent are categorized; see col. 2 lines 3-6; abstract; col. 2 lines 1-40*); receiving an inbound communication from a third user (col. 2 lines 1-40); identifying an online identity of the third user that sent the inbound communication (fig 4; col. 2 lines 1-40); and regulating communications between the first user and the third user based on whether the online identity identified to have sent the inbound communication is included among one or more of the first and second lists (*identifications comprise any identifying means which another entity can communicate with; see col. 3 lines 59-62*).

Response to Arguments

Applicant's arguments filed 06/05/08 have been fully considered but they are not persuasive.

Applicant argued that For instance, with respect to claim 1, Dieterman does not describe or suggest inferring that a person is associated with the user based, at least in part, on inclusion of the person in a contact list of a second person, wherein the second person is not the user, and then adding the inferred person to the list of people associated with the user, as recited in claim 1. There are two lists recited: (i) a contact list of a second person who is not the user; and (ii) the list of people associated with the user. A person is inferred to be associated with the user based on his or her inclusion on one list, and then added to the second list.

Examiner submits that applicant has misinterpreted the prior art of record. Dieterman is directed to a method of controlling delivery of electronic mail messages.

The method comprises adding e-mail address to allowed lists based on a combination

of multiple actions. For instance, the actions can be opening, viewing, reading,

categorizing, deleting and adding email messages (see fig 4; col. 2 lines 1-40).

Dieterman broadly describes the process of adding a contact or email address to

approved lists. Accordingly, the rejection is maintained.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Frantz B. Jean whose telephone number is 571-272-

3937. The examiner can normally be reached on 8:30-6:00 M-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Frantz B. Jean/
Primary Examiner, Art Unit 2454